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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/527,705	03/17/2000	Robert A. Luciano	732.083	3145

21707 7590 07/29/2003

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EXAMINER
MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
3713	12

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

Office Action Summary	Application No.	Applicant(s)	
	09/527,705	LUCIANO, ROBERT A.	
	Examiner	Art Unit	
	C. Marks	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,9,10,12-14,19-40,45-50,52,54,56,65-66,70,74,76 and 77* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,9,10,12-14,19-40,45-50,52,54,56,65-66,70,74,76 and 77* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

The objection to claims 49 and 70 due to the claims depending on cancelled claims has been hereby withdrawn due to the amendment filed 20 May 2003.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 9, 10, 12-14, 19-36, 50, 52, 54, 56, 65, 66, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff (US Patent No. 6,224,483) in view of Stanley (GB 2,320,206) further in view of Crawford et al. (US Patent No. 6,270,412).

Mayeroff et al. disclose a gaming apparatus to play games of chance wherein the apparatus consists of a first housing portion housing a spinning reel first game of chance (FIG 2, reference 110) with an outcome display, an award display (FIG 1, reference 40), a first game actuator (FIG 2, reference 138) that is activated for play by the game player. Furthermore, the apparatus consists of a second housing portion housing a spinning wheel second game of chance (FIG 2, reference 150) with a range of outcomes that can alter the award to the game player (Abstract) by providing an additional award. The second game of chance is mounted atop the first and is proximate and adjacent in an integral game frame with the first game of chance whereby the player can observe both games from one location (FIG 1) and the second game of chance has an outcome display and an actuator (FIG 2, reference 140) that is activated by the primary gaming unit has randomly selected one of a plurality of indicia sets (Column 5, lines 23-

26). All spins of the rotating wheel bonus game are winning spins (Abstract, lines 14-15) therefore the wheel outcome includes an award to the game player.

Stanley teaches of an amusement apparatus that has a first type of game that upon a predetermined completion will initialize a second type of game and success on the second game will lead to a further game on the first game (Abstract). In the disclosed apparatus, the second game of chance can lead to an alteration of the result of the first game of chance (page 5, lines 21-23) by obtaining a predetermined alteration outcome as a result of the game, such as rotating the reels (FIG 4, reference 10, NUDGES, SPIN A WIN) and changing the first game outcome in the first game outcome display and providing a chance-improving outcome as the reels can then be moved to a winning combination. Further another alteration of the first game outcome provided for by the second game would be to spin until a win is achieved (FIG 4, reference 10, SPIN A WIN). The second game of chance is connected to the first game and is activated upon predetermined completion of the first game (Abstract). Stanley discloses that upon success in the second game of chance, the first game of chance can again be replayed (Abstract). Stanley also discloses an additional award can be won from the second game based upon a predetermined outcome (FIG 4, reference 10, win L3) thereby increasing the total award provided to the player. Though Stanley does not distinctly disclose that upon the first game of chance being played again, the second game of chance is again activated, this is strongly implied to one or ordinary skill in the art by Stanley in that the bonus game allows the play of the first game to again occur (Abstract, "successful completion of the fruit machine game initiating play on the pinball game and successful completion of the pinball games leading to a further game on the fruit machine") and thus it would be understood by one of ordinary skill in the art that the

same paytable is again used as was in the original game. Therefore, if the "nudges" or "spin until a win" are obtained from the bonus game in order to replay the first game, if a result in the replay of the first game resulted in a predetermined completion associated with the bonus game, the bonus game would obviously be re-enacted. Further, the logic used that causes the first game to initiate the bonus game would obviously still be present upon a re-entrance of the first game as caused by the second game. One of ordinary skill in the art would understand that upon re-entering the first game, the same rules would be used to determine winnings, including possible situation to enact the bonus again. One of ordinary skill in the art would further be motivated to apply the same rules used previously in the base game, as it would be even more complex to change them. For example, if a "7 7 7" caused a bonus game to occur, and in the bonus game the player achieved a "spin a win" award and again upon playing the base game received a "7 7 7" representing a win, one of ordinary skill in the art would understand and surely find it reasonable to Stanley and suggested that a bonus game would then be reenacted based on the disclosure of Stanley and that which is known in the art.

Crawford teaches of a slot machine with a symbol save feature which allows a player to save in memory (and retrieve for later use in determining a winning combination) one or more symbols from one or more previous games and use those symbols in a current or future game to obtain a winning combination (Abstract, lines 3-5) and alter the likelihood of obtaining an award. The symbol save feature can be saved from a game of chance and transferred to another game of chance output display (Abstract, lines 6-8). This device is located on the gaming machine (FIG 5, reference 54).

Applicant notes that an ongoing motivation of the gaming industry is to develop slot type machines that are more exciting to play and thus more likely to be played and generate revenue. Stanley teaches of an amusement device where play is more exciting given the fact that the bonus round can alter the base round and there are such bonus awards as spin until a win and nudge. With these additional features, the bonus game would become much more exciting to the user as there is higher anticipation of a positive result from the bonus. By incorporating an apparatus that provides the user with a higher anticipation of an award and greater excitement, the lure of the machine is greatly increased and the goal of the gaming industry is met as the slot machine is more exciting to play and thus more likely to be played and generate revenues. For these reasons, it would have been obvious to one skilled in the art at the time of invention to incorporate the bonus round teachings of Stanley into the apparatus of Mayeroff to create a game of chance where the bonus round is more exciting and enticing to the user.

Further, as is well known in the art, when a user perceives a greater chance of winning on a gaming machine, the user is more likely to participate in play of that machine. By incorporating the symbol save feature of Crawford into the apparatus of Mayeroff in view of Stanley, the user would get even more enjoyment out of the bonus round as it would be possible to save a bonus features for use at a later time. Therefore, it would have been obvious to one skilled in the art at the time of invention to incorporate the teachings of Crawford into the apparatus of Mayeroff in view of Stanley to create a bank in which the user could store a symbol obtained in the bonus round for use in the primary round at a later time in order to give the user a feeling of better control over their own fate in the game, thus giving a perception of a greater likelihood of award winnings.

Regarding the method steps of claims 65, 66, and 70, Mayeroff teaches a method of a base game of chance used to procure a first base game outcome and upon the appearance of a predetermined outcome, a bonus opportunity is given (Abstract). Mayeroff also then teaches of actuating the bonus game of chance to procure a bonus game outcome and upon the appearance of a predetermined outcome, an award is given. Stanley teaches a method of once the bonus game is initialized, awarding the player to again play the base game of chance upon a certain combination (Abstract). Crawford teaches a method of using a bank portion for a bonus game to transfer the symbol to a base game of chance. Based upon the obviousness to combine these references and the motivation stated above, it would have been obvious to one of ordinary skill in the art to incorporate the method disclosures garnished from the teachings into the device as disclosed above.

Claims 37-40, 45-49, 74, 76, and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff (US Patent No. 6,224,483) in view of Stanley (GB 2,320,206) further in view of Crawford et al. (US Patent No. 6,270,412) further in view of Kaku.

What Mayeroff, Stanley, and Crawford disclose, teach, and/or suggest has been discussed above and is incorporated herein.

Kaku et al. teaches of increasing user enjoyment by increasing the number of combinations that would produce a winning result (page 3, lines 11-14). To address this issue, the disclosed invention includes three donut-shaped disks that are in a concentric relation (page 4, lines 1-2) and have patterns of numbers, letters, or pictures (page 4, line 25). The disks are

rotated independently and are stopped separately (page 5, line 1-2), thus they spin sequentially. Moreover, the number of disks can be made two (page 8, line 15).

By replacing the wheel device of the bonus round with the concentric wheel device taught by Kaku et al., the user would enjoy the bonus round more as the number of winning combinations would appear to be or actually be increased. This would provide more excitement to the user than a solo rotating wheel as there would be more than one rotating factor involved in determining the result of the bonus round. Therefore, it would have been obvious to one skilled in the art at the time of invention to incorporate a different design choice as a means for presenting the bonus round. By incorporating the design choice taught by Kaku et al., the user would experience a greater sense of enjoyment from the bonus round as it would be more exciting when a plurality of spinning wheels are involved and a greater sense of a winning possibility is experienced.

Response to Amendment

The declaration of Loren Nelson under 37 CFR 1.132 filed 20 May 2003 is insufficient to overcome the rejection of all claims based upon the Stanley reference under 35 U.S.C. 103(a) as set forth in the last Office action because:

In referring to MPEP §716.01(c), the Examiner must consider the probative value of an expert opinion including the interest of the Expert of the case. Examiner notes as per paragraph 2 of the Nelson declaration that the interest of the expert witness is that of an employee of the company that owns the present Application.

As per paragraph 8, the opinion of the expert is that of an allegation. The Examiner agrees that the Stanley reference is of the physical parameters defined by the expert; however,

the Examiner asserts that the expert has failed to show how the Stanley reference is not enabled for the features that are being relied upon by the Examiner. The expert merely states that Stanley is not enabled.

As per paragraph 9, the expert states that it is estimated that the amount of time required for ordinary artisans to build the machine of Stanley would require at least 1.5 man-years. However, the Examiner asserts that there is no factual support for the expert's opinion in this instance. For example, it is of the opinion of the expert as disclosed above that it would take 1.5 man-years to engineer and design the Stanley reference. There is no documentary support evidence provided for how this conclusion was reached or what, if any, equations were used. As of now, this is a merely the expert's opinion. The argument would have more weight if it were directed only to the features being relied upon by the Examiner and proof as to how the calculation was obtained was provided.

As per paragraph 10, the expert is making a conclusionary statement that is unsupported by factual evidence and support for the position and is merely speculation.

As per paragraphs 11-13, the expert has only asserted opinion and provided no evidence support or reasoning why it is believed the machine of Stanley would not include a paytable that would re-enact the bonus game again if being reset to the first game. There is no support for the assertion that one of ordinary skill in the art would understand that the first game could be re-initiated by the second game, but not that the second game could also be re-initiated by the re-initiated first game. The examiner asserts that there is no support provided for this opinion and the expert gives no counter reasoning as to what the expert believes one of ordinary skill in the art would expect the game to do at this stage and why the Stanley reference does not make the

suggestion asserted by the Examiner to one of ordinary skill in the art. The expert also states that they do not believe that the paytable for the desired Stanley machine should be and most likely would be structured to allow for re-initiation of the first game by the second game but without providing, in turn, any re-initiation of the second game by the re-initiated first game. The statement is conclusionary and provides no factual support or reasoning for why this is believed or thought by the expert. Further, the repeated allegation that Stanley does not imply such a paytable or suggest such is not convincing as per stated above.

In conclusion, the expert's assertions have been respectfully considered but are not found to be persuasive. The declaration is lacking the facts and actual evidence to support the basis of the expert's opinion and allegation. Thus the affidavit is lacking in basis for the expert's opinion. The expert needs to supply documentary evidence with factual support in order for the opinions stated to be more heavily considered.

Response to Arguments

Applicant's arguments filed 28 January 2003 have been fully considered but they are not persuasive.

In response to the Applicant's arguments that the Stanley reference provides no teaching of how to make and use such a feature, the Examiner respectfully disagrees with the position that the Stanley reference is non-enabling with respect to the bonus game and base game. One of ordinary skill in the art would understand how to make and use the Stanley reference as a gaming machine where the bonus round creates a chance to replay the base game. Incorporating features such as nudge and spin a win are well known in the art and therefore are enabled with respect to the teachings being relied upon by Stanley. The Examiner does not rely on the entire physical

apparatus of Stanley as a reference; certain teachings are merely cited and these are only what is required to be enabled and as asserted above, the Examiner believes that these features are indeed enabled by one of ordinary skill in the art.

With respect to the Applicant's argument that Stanley does not inherently teach or even imply the particular paytable and re-enacting of the bonus game as asserted, the Examiner respectfully disagrees. As disclosed above, the features are implied by Stanley. To address this situation, the Examiner has expounded this position above in the rejection and will repeat it here for clarity. Though Stanley does not distinctly disclose that upon the first game of chance being played again, the second game of chance is again activated, this is strongly implied by Stanley in that the bonus game allows the play of the first game to again occur (Abstract, "successful completion of the fruit machine game initiating play on the pinball game and successful completion of the pinball games leading to a further game on the fruit machine") and thus it would be understood by one of ordinary skill in the art that the same paytable is again used as was in the first game. Therefore, if the "nudges" or "spin until a win" are obtained from the bonus game in order to replay the first game result in a the predetermined completion associated with the bonus game, the bonus game would obviously be re-enacted. Further, the logic used that causes the first game to initiate the bonus game would obviously still be present upon a re-entrance of the first game as caused by the second game. One of ordinary skill in the art would understand that upon re-entering the first game, the same rules would be used to determine winnings, including possible situation to enact the bonus again. One of ordinary skill in the art would further be motivated to apply the same rules used previously in the base game, as it would be even more complex to change them. For example, if a "7 7 7" caused a bonus game to occur,

and in the bonus game the player achieved a "spin a win" award and again upon playing the base game received a "7 7 7" representing a win, one of ordinary skill in the art would understand and surely find it reasonable to Stanley and suggested that a bonus game would then be reenacted based on the disclosure of Stanley and that which is known in the art. The Examiner believes that one of ordinary skill in the art would find the implications from Stanley to re-enact the base game for the reasons stated above.

In response to the Applicant's argument that the test for enablement is not just whether an engineer in the art could make a machine eventually, the Examiner agrees that that is the test; however, asserts that the reference need only be enabled for the features it is being relied upon for and as disclosed above the Examiner believes in the present case, the reference is enabling.

In response to the Applicant's argument about that which the declaration states, the Examiner has respectfully considered the declaration; however, as will be disclosed above, has not found it to be persuasive. Arguments that are thus based upon the expert's opinion are not persuasive for the reasons detailed above.

In response to the Applicant's arguments that the generalized motivation in the industry to provide more exciting games is not a motivation to select the asserted features and combine the three references, the Examiner respectfully disagrees. The features selected are based upon more exciting games. In the Stanley reference, this is the capability to re-enter the bonus game after the base game and in the Crawford reference, this is the ability to save certain symbols for use at a later time. These features provide requisite motivation to select and choose them, as they are both known in the art to further attract users and make the game more exciting with possibilities.

In response to the Applicant's arguments that there is no motivation or suggestion to select, pick, and choose features from four references, the Examiner respectfully disagrees. The combination of Kaku et al. was used in order to provide support for an alternate embodiment of the invention wherein instead of three drums spinning independently, a concentric wheel game is used in said. Such a substitution is notoriously well known in the art as disclosed by the Examiner and would be an obvious design choice to an ordinary artisan as an obvious alternative to using three drums not only because such a substitution is notoriously well known, but also because as disclosed by Kaku et al. that it is a more enjoyable presentation method to users. The Examiner asserts that this combination of select features from four references does not constitute impermissible hindsight for the reasons disclosed above. The Examiner asserts there is adequate motivation as would be present to one of ordinary skill in the art and the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Different motivations exist to those of ordinary skill in the art and though they differ from one artisan to another, these motivations are still suggested by the record. Further, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *MPEP 2145 X.* In the instant case, it is well known in the art that creating bonus games that present the user with the sense that they have a better chance of winning is a goal of the gaming industry. The teachings of Stanley

disclose that a bonus game that is enacted by a base game can provide a further game on the base game to improve the chances of winning. The teachings of Crawford disclose that a symbol can be saved from a base game and then applied to a later or bonus game to improve the chances of winning. All of these teachings are drawn towards improving the chance of winning in a bonus game for a user. These teachings constitute a motivation in that they provide an improved chance in a bonus game enacted by a base game, such as the disclosed of Mayeroff. One of ordinary skill in the art would be motivated henceforth to combine these teachings in order to provide features that will give the user a better sense of a winning possibility. Further motivation resides in the fact, that upon combination, users would be more enticed to play a game that they perceive having a better chance of earning winnings, thus creating a more prolonged play and increased revenue for the casino. Such a motivation is well known in the art and therefore creating combinations to reach the goal of increasing user enjoyment would be obvious to one of ordinary skill in the art.

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *MPEP 2145 V.*

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,491,584: Upon a further search, this document was found to be of particular relevance to the claimed invention.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael O'Neill, Acting SPE, can be reached on (703)-308-3484. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

cmm
July 25, 2003

MICHAEL O'NEILL
PRIMARY EXAMINER